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09/983,041	10/22/2001	Atsushi Shibuya	PF-2894/NEC/US/mh	8200
30743 7590 07/25/2007 WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190			EXAMINER NGUYEN, HAI V	
			ART UNIT 2142	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/983,041

Applicant(s)

SHIBUYA, ATSUSHI

Examiner

Hai V. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29, 31-38, 40-47 and 49-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29, 31-38, 40-47 and 49-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is in response to the communication received on 28 March 2007.
2. Claims 30, 39, 48 were cancelled.
3. Claims 1-29, 31-38, 40-47 and 49-55 are presented for examination.

### ***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "at least one retrieval condition, at least one corresponding identifier" in claim 1, the "a retrieval condition" in claims 16, 29, 38, 47 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

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Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

5. Claims 1, 16 are objected to because of the following informalities:
6. There is inconsistent in the limitation of “at least one corresponding identifier for an image or sound file to be displayed” in claim 1 and the limitation of “at least one corresponding identified image or sound file” in claim 16. Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 29, 31-37, 47, 49-55 are rejected under 35 U.S.C. 101 because the claim 29 recites the elements of “a first function block, a second function block” and claims 47, 49-55 recite the element of “a computer program”, which when read in light of specification amounts to nothing more than computer software void of computer readable medium. See MPEP 2106(IV)(B)(1)

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-29, 31-38, 40-47 and 49-55 are rejected under 35 U.S.C. 102(e) as being anticipated by **Maeda et al. US patent # 6,973,458 B1**.

11. As to claim 1, Maeda discloses a communication system (*Fig. 1*) including:

a communication network (*Fig. 1*); and

a plurality of terminal devices (*Fig. 1, users 101, 102 103, 113-115*) connectable to said communication network for transmitting from a sender (*Fig. 1, email sender 102*) and receiving by a user (*Fig. 1, email browser 114 of client 112*) an information item (*a structured document or an email*) through said communication network (*Fig. 1, col. 10, lines 5-17; col. 16, lines 34-43*);

wherein said communication system includes a table (*a structured document important item condition table / a structured document important item related attaching item condition table, col. 20, lines 1-12, col. 20, line 66 – col. 21, line 6*) which provides at least one retrieval condition (*keyword(s)/ tag(s)*) and for each said retrieval condition at least one corresponding identifier for an image file to be displayed (*the important items or the extracted portions to be displayed*), so as to enable said terminal devices of said

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user to detect (*to search and to read out*) in said information item said at least one retrieval condition and if the retrieval condition is detected (*searched, read out*) to display said information item with said at least one corresponding identified image file (*Figs. 3, 22, col. 11, lines 31-43; col. 9, lines 5-23; col. 29, line 62 – col. 30, line 38*).

12. As to claim 2, Maeda discloses wherein each retrieval condition in said table comprises a key object (*col. 19, line 26 – col. 20, line 12; col. 20, line 30 – col. 21, line 6*).

13. As to claim 3, Maeda discloses wherein each said key object comprises at least one object selected from the group consisting of key words and key marks (*col. 19, line 26 – col. 20, line 12; col. 20, line 30 – col. 21, line 6*).

14. As to claim 4, Maeda discloses wherein said table includes designating data (*tags*) which designate data for displaying said information item with said at least one corresponding identified image file (*col. 19, line 26 – col. 20, line 12; col. 20, line 30 – col. 21, line 6*).

15. As to claim 5, Maeda discloses wherein said table includes necessary data for displaying said information item with said at least one corresponding identified image file (*col. 19, line 26 – col. 20, line 12; col. 20, line 30 – col. 21, line 6*).

16. As to claim 6, Maeda discloses wherein said table is editable (*specify, add, change, delete, col. 18, lines 48-61; col. 19, line 26 – col. 20, line 12; col. 20, line 30 – col. 21, line 6*).

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17. As to claim 7, Maeda discloses wherein said table is transferable (*sharing*) through said communication network (*Figs. 3, 22, col. 11, lines 31-43; col. 9, lines 5-23; col. 29, line 62 – col. 30, line 38*).

18. As to claim 8, Maeda discloses wherein said information item comprises an e-mail (*Figs. 3, 22, col. 11, lines 31-43; col. 9, lines 5-23; col. 29, line 62 – col. 30, line 38*).

19. As to claim 9, Maeda discloses wherein said e-mail has at least an attached file (*Figs. 3, 22, col. 11, lines 31-43; col. 9, lines 5-23; col. 29, line 62 – col. 30, line 38*).

20. As to claim 10, Maeda discloses wherein said table is stored in a memory of said terminal device (*Figs. 3, 22, col. 11, lines 31-43; col. 9, lines 5-23; col. 18, lines 48-61; col. 19, line 26 – col. 20, line 12; col. 20, line 30 – col. 21, line 6; col. 29, line 62 – col. 30, line 38*).

21. As to claim 11, Maeda discloses, wherein said table is open on a server computer on said communication network, so as to enable said terminal device to download said table from said server (*Figs. 3, 22, col. 11, lines 31-43; col. 9, lines 5-23; col. 18, lines 48-61; col. 19, line 26 – col. 20, line 12; col. 20, line 30 – col. 21, line 6; col. 29, line 62 – col. 30, line 38*).

22. As to claim 12, Maeda discloses wherein each of said terminal devices includes: a first function block (*a retrieval function, col. 19, lines 16-25*) for performing said retrieval under said retrieval condition with reference to said table; and a second function block (*Fig. 1, the email browser 114, col. 11, lines 36-42*) for displaying said information item in accordance with said at least one corresponding

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identified image file (*Figs. 3, 22, col. 11, lines 31-43; col. 9, lines 5-23; col. 18, lines 48-61; col. 19, line 26 – col. 20, line 12; col. 20, line 30 – col. 21, line 6; col. 29, line 62 – col. 30, line 38*).

23. As to claim 13, Maeda discloses wherein each of said terminal devices further includes:

a third function block (*Fig. 1, the client 112, col. 2, lines 33-39*) for transmitting and receiving said table through said communication network (*col. 9, lines 5-28*).

24. As to claim 14, Maeda discloses wherein each of said terminal devices includes:

a processing unit (*Fig. 1, col. 9, lines 5-28; col. 12, lines 49-52*); and

a memory accessible by said processing unit, and said memory storing a computer program (*Fig. 1, recording device 111*) comprising the steps of

means for performing said retrieval under said at least one retrieval condition with reference to said table (*Figs. 3, 22, col. 11, lines 31-43; col. 9, lines 5-23; col. 18, lines 48-61; col. 19, line 26 – col. 20, line 12; col. 20, line 30 – col. 21, line 6; col. 29, line 62 – col. 30, line 38*); and

means for displaying said information item in accordance with said at least one corresponding identified image file (*Figs. 3, 22, col. 11, lines 31-43; col. 9, lines 5-23; col. 18, lines 48-61; col. 19, line 26 – col. 20, line 12; col. 20, line 30 – col. 21, line 6; col. 29, line 62 – col. 30, line 38*).

25. As to claim 15, Maeda discloses transmitting and receiving said table through said communication network (*Figs. 3, 22, col. 11, lines 31-43; col. 9, lines 5-23; col. 18,*



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*lines 48-61; col. 19, line 26 – col. 20, line 12; col. 20, line 30 – col. 21, line 6; col. 29, line 62 – col. 30, line 38).*

26. Claim 16 corresponds to the apparatus claim of claim 1; therefore, it is rejected under the same rationale as in claim 1.

27. Claims 17-24 introduce identical limitations of claims 2-9; therefore, they are rejected under the same rationale as in claims 2-9.

28. Claims 25-28 introduce identical limitations of claims 12-15; therefore, they are rejected under the same rationale as in claims 12-15.

29. Claim 29 corresponds to the apparatus claim of claim 1; therefore, it is rejected under the same rationale as in claim 1.

30. Claims 31-37 introduce identical limitations of claims 2, 4-9; therefore, they are rejected under the same rationale as in claims 2, 4-9.

31. As to claim 38, Maeda discloses a method of displaying information, comprising the steps:

detecting (*searching and reading out*) in an information item (*an email*) a retrieval condition (*a keyword or a tag*), said retrieval condition having been inserted in said information item by the sender and said information item having been transmitted over a communication network by said sender to a user; and  
displaying said information item with at least one image file (*an important item; an extracted portion*) identified as corresponding to said detected retrieval condition, wherein said retrieval condition and each said identified image file corresponding to said retrieval condition is recorded in a table and said detecting is performed with reference

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to each one of more retrieval conditions in said table, said displaying being performed for each detected retrieval condition, said sender and said user each being capable of executing said method (*Figs. 3, 22, col. 11, lines 31-43; col. 9, lines 5-23; col. 18, lines 48-61; col. 19, line 26 – col. 20, line 12; col. 20, line 30 – col. 21, line 6; col. 21, line 60 – col. 22, line 23; col. 29, line 62 – col. 30, line 38*).

32. Claims 40-46 introduce identical limitations of claims 2-6, 8-9; therefore, they are rejected under the same rationale as in claims 2-6, 8-9.

33. Claim 47 corresponds to the computer readable medium claim of claim 38; therefore, it is rejected under the same rationale as in claim 38.

34. Claims 49-55 introduce identical limitations of claims 40-46; therefore, they are rejected under the same rationale as in claims 40-46.

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35. Claims 1-29, 31-38, 40-47 and 49-55 are rejected under 35 U.S.C. 102(e) as being anticipated by **Cruickshank US 2003/0158734 A1**.

36. As to claim 1, Cruickshank discloses a communication network (*Fig. 1, a message system 104*); and a plurality of terminal devices connectable to said communication network for transmitting from a sender and receiving by a user an information item (*an email message, [0009]-[0013], [0026]*) through said communication network;

wherein said communication system includes a table (*a list of textual units*) which provides at least one retrieval condition (*word(s)*) and for each said retrieval condition at least one corresponding identifier for a sound file to be displayed, so as to enable said

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terminal devices of said user to detect in said information item said at least one retrieval condition and if the retrieval condition is detected (*searched, spoken out*) to display said information item with said at least one corresponding identified image or sound file (*Figs. 2, 4, [0031]-[0033], [0040]*).

37. As to claim 2, Cruickshank discloses wherein each retrieval condition in said table comprises a key object (*Figs. 2, 4, [0009]-[0013], [0026], [0031]-[0033], [0040]*).

38. As to claim 3, Cruickshank discloses wherein each said key object comprises at least one object selected from the group consisting of key words and key marks (*Figs. 2, 4, [0009]-[0013], [0026], [0031]-[0033], [0040]*).

39. As to claim 4, Cruickshank discloses wherein said table includes designating data (*words*) which designate data for displaying said information item with said at least one corresponding identified image or sound file (*Figs. 2, 4, [0009]-[0013], [0026], [0031]-[0033], [0040]*).

40. As to claim 5, Cruickshank discloses wherein said table includes necessary data for displaying said information item with said at least one corresponding identified image or sound file (*Figs. 2, 4, [0009]-[0013], [0026], [0031]-[0033], [0040]*).

41. As to claim 6, Cruickshank discloses wherein said table is editable (*specify, add, change, delete, Figs. 2, 4, [0009]-[0013], [0026], [0031]-[0033], [0040]*).

42. As to claim 7, Cruickshank discloses wherein said table is transferable through said communication network (*Figs. 2, 4, [0009]-[0013], [0026], [0031]-[0033], [0040]*).

43. As to claim 8, Cruickshank discloses wherein said information item comprises an e-mail (*Figs. 2, 4, [0009]-[0013], [0026], [0031]-[0033], [0040]*).

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44. As to claim 9, Cruickshank discloses wherein said e-mail has at least an attached file (*Figs. 2, 4, [0009]-[0013], [0026], [0031]-[0033], [0040]*).

45. As to claim 10, Cruickshank discloses wherein said table is stored in a memory of said terminal device (*Figs. 2, 4, [0009]-[0013], [0026], [0031]-[0033], [0040]*).

46. As to claim 11, Cruickshank discloses, wherein said table is open on a server computer (*Abstract*) on said communication network, so as to enable said terminal device to download said table from said server (*Abstract, Figs. 2, 4, [0009]-[0013], [0026], [0031]-[0033], [0040]*).

47. As to claim 12, Cruickshank discloses wherein each of said terminal devices includes:

a first function block (*engine 206*) for performing said retrieval under said retrieval condition with reference to said table; and a second function block (*PCM output*) for displaying said information item in accordance with said at least one corresponding identified image or sound file (*Figs. 2, 4, [0009]-[0013], [0026], [0031]-[0033], [0040]*).

48. As to claim 13, Cruickshank discloses wherein each of said terminal devices further includes:

a third function block (*email messaging*) for transmitting and receiving said table through said communication network (*Figs. 2, 4, [0009]-[0013], [0026], [0031]-[0033], [0040]*).

49. As to claim 14, Cruickshank discloses wherein each of said terminal devices includes:

a processing unit (*Fig. 2; 102, [0009]-[0013], [0026], [0031]-[0033], [0040]*); and

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a memory accessible by said processing unit, and said memory storing a computer program (*Fig. 2; 204, [0009]-[0013], [0026], [0031]-[0033], [0040]*) comprising the steps of

means for performing said retrieval under said at least one retrieval condition with reference to said table (*Figs. 2, 4, [0009]-[0013], [0026], [0031]-[0033], [0040]*); and

means for displaying said information item in accordance with said at least one corresponding identified image or sound file (*Figs. 2, 4, [0009]-[0013], [0026], [0031]-[0033], [0040]*).

50. As to claim 15, Cruickshank discloses transmitting and receiving said table through said communication network (*Figs. 2, 4, [0009]-[0013], [0026], [0031]-[0033], [0040]*)

51. Claim 16 corresponds to the apparatus claim of claim 1; therefore, it is rejected under the same rationale as in claim 1.

52. Claims 17-24 introduce identical limitations of claims 2-9; therefore, they are rejected under the same rationale as in claims 2-9.

53. Claims 25-28 introduce identical limitations of claims 12-15; therefore, they are rejected under the same rationale as in claims 12-15.

54. Claim 29 corresponds to the apparatus claim of claim 1; therefore, it is rejected under the same rationale as in claim 1.

55. Claims 31-37 introduce identical limitations of claims 2, 4-9; therefore, they are rejected under the same rationale as in claims 2, 4-9.

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56. As to claim 38, Cruickshank discloses a method of displaying information, comprising the steps:

detecting (*searching and speaking out*) in an information item (*an email*) a retrieval condition (*a word*), said retrieval condition having been inserted in said information item by the sender and said information item having been transmitted over a communication network by said sender to a user (*Figs. 2, 4, [0009]-[0013], [0026], [0031]-[0033], [0040]*); and

displaying said information item with at least one image or sound file identified as corresponding to said detected retrieval condition,

wherein said retrieval condition and each said identified image or sound file corresponding to said retrieval condition is recorded in a table and said detecting is performed with reference to each one of more retrieval conditions in said table, said displaying being performed for each detected retrieval condition, said sender and said user each being capable of executing said method (*Figs. 2, 4, [0009]-[0013], [0026], [0031]-[0033], [0040]*).

57. Claims 40-46 introduce identical limitations of claims 2-6, 8-9; therefore, they are rejected under the same rationale as in claims 2-6, 8-9.

58. Claim 47 corresponds to the computer readable medium claim of claim 38; therefore, it is rejected under the same rationale as in claim 38.

59. Claims 49-55 introduce identical limitations of claims 40-46; therefore, they are rejected under the same rationale as in claims 40-46.

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60. Further references of interest are cited on Form PTO-892, which is an attachment to this action.

***Response to Arguments***

61. Applicant's arguments with respect to claims 1, 16, 29, 38, 47 have been considered but are moot in view of the new ground(s) of rejection.

62. In the remarks, Applicant argued in substance that:

Point (A), the prior art do not disclose that, "the table is applied directly by the email receiver and based upon an evaluation done by that user upon the text received from the sender" (page 15).

As to point (A), Maeda disclose in figure 3 the table is applied directly by the receiving user 114 and based upon an evaluation done by that user upon the items received from the email sender 102 (Figs. 1, 3).

Point (B), the prior art do not disclose that, "the detection of the retrieval condition, the detection being done by the user from the text transmitted by the sender" (page 15).

As to point (B), Maeda discloses in figure 3 that, upon receiving the email, the email browser 114 displays the email (step 309). At this point, if the important items are contained in the email, the tags indicating that they are extracted are attached by the document important item extraction device 110" (col. 11, lines 5-42).

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### ***Conclusion***

63. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai V. Nguyen whose telephone number is 571-272-3901. The examiner can normally be reached on 6:00-3:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hai V. Nguyen  
Examiner  
Art Unit 2142



ANDREW CALDWELL  
SUPERVISORY PATENT EXAMINER